



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/777,246 | 12/31/1996 | KAZUOMI OISHI | 35.G1868 | 3060 |

5514 7590 08/12/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| |
|----------|
| EXAMINER |
|----------|

SONG, HOSUK

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2131

DATE MAILED: 08/12/2003

38

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/777,246

Applicant(s)

OISHI, KAZUOMI

Examiner

Hosuk Song

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 5/19/03 has been entered.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Moghadam et al.(US 5,801,856).

Claim 34: Moghadam disclose first input for inputting data in (fig.1 and col.4,lines 33-35,50-56). Second input for inputting secret key information stored in an external device is disclosed by Moghadam in (fig.1 and fig.3,#36). Generating a digital signature using the data and secret key information is disclosed by Moghadam in (col.4,lines 35-40,43-49). Outputting the digital signature to the external device is disclosed by Moghadam in (fig.5,#58).

Claim 35: Compression mean is taught by Moghadam in (fig.3,#40).

Claim 36: Moghadam disclose first input for inputting data in (fig.1 and col.4,lines 33-35,50-56). Second input for inputting secret key information stored in an external device is disclosed by Moghadam in (fig.1 and fig.3,#36).

Art Unit: 2131

Generating a digital signature using the data and secret key information is disclosed by Moghadam in (col.4,lines 35-40,43-49). Outputting the digital signature to the external device is disclosed by Moghadam in (fig.5,#58).

Claim 37: Moghadam disclose all the limitations. It is inherent in system of Moghadam to include some type of software or program code to carry out such function as generating a digital signature and process key information.

Claim 38: : Moghdam disclose first input for inputting data in (fig.1 and col.4,lines 33-35,50-56). Second input for inputting secret key information stored in an external device is disclosed by Moghadam in (fig.1 and fig.3,#36).

Generating a digital signature using the data and secret key information is disclosed by Moghadam in (col.4,lines 35-40,43-49). Outputting the digital signature to the external device is disclosed by Moghadam in (fig.5,#58).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Merkle et al.(US 5,157,726).

Claim 34: Merkle disclose first input for inputting data in (fig.1A). Second input for inputting secret key information stored in an external device is disclosed by Merkle in (fig.1A). Generating a digital signature using the data and secret key information is disclosed by Merkle in (col.6,lines 41-51). Outputting the digital signature to the external device is disclosed by Merkle in (col.6,lines 52-58).

Claim 35: Compression mean is taught by Merkle in (col.7,lines 65-68;col.8,lines 1-2).

Art Unit: 2131

Claim 36: Merkle disclose first input for inputting data in (fig.1A). Second input for inputting secret key information stored in an external device is disclosed by Merkle in (fig 1A). Generating a digital signature using the data and secret key information is disclosed by Merkle in (col.6,lines 41-51). Outputting the digital signature to the external device is disclosed by Merkle in (col.6,lines 52-58).

Claim 37: Merkle disclose all the limitations. It is inherent in system of Merkle to include some type of software or program code to carry out such function as generating a digital signature and process key information.

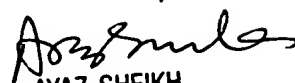
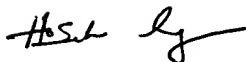
Claim 38: Merkle disclose first input for inputting data in (fig.1A). Second input for inputting secret key information stored in an external device is disclosed by Merkle in (fig.1A). Generating a digital signature using the data and secret key information is disclosed by Merkle in (col.6,lines 41-51). Outputting the digital signature to the external device is disclosed by Merkle in (col.6,lines 52-58).

Conclusion

3. Any inquiry concerning this communication should be directed to Hosuk Song whose telephone number is (703)305-0042. The examiner can normally be reached on Tuesday – Friday from 6:00 am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703)305-9648.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703)305-3900.



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100